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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,537	02/14/2004	Bao Tran	IPgineering-002	8990

31688 7590 07/26/2006

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EXAMINER

PHAM, MICHAEL

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/779,537	Applicant(s) TRAN, BAO	
	Examiner Michael D. Pham	Art Unit 2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/30/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

1. Claims 1 - 20 have been examined.
2. Claims 1 - 20 are pending.
3. Claims 1 - 20 are rejected as detailed below.

Priority

The application does not claim foreign or domestic priority. Accordingly, the application has been examined with an effective filing date of 02/14/2004.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 19-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. It appears that in the claimed subject matter for claim 19, all elements would reasonably be interpreted by one of ordinary skill in light of the disclosure as software, such that the system is software per se. Claim 20 fails to resolve the deficiencies of claim 19 and therefore is also rejected.

Claim 16-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. It appears that in the claimed subject matter for claim 16, all elements would reasonably be interpreted by one of ordinary skill in light of the disclosure as software,

Art Unit: 2167

such that the system is software per se. Claims 17-18 fail to resolve the deficiencies of claim 16 and therefore are also rejected.

Claim 1-20, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 14, 16, and 20 do not appear to provide a tangible result.

There appears to be no practical application being claimed. There is the step of searching for relevant patents, and then performing a network analysis on the patents for claims 1 and 16.

Claims 14 and 20 disclose receiving, searching, retrieving patent information based on queries, and then updating and repeating the steps. However, it appears no result for mapping the intellectual property is being claimed. All other claims fail to resolve the deficiencies of the claims from which they depend from.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4-13, 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2003/0004936 by Grune et. al. (hereafter Grune).

Claim 1:

A method for mapping intellectual property[Grune, 0010, search and map patents.],
comprising:

searching one or more remote databases for one or more relevant patents [Grune, 0027, allows a user to enter a query via a client computer that is connected to a server on a global area network. Intelligent searching also provides a user access to the stored intellectual property and scientific information contained on various databases.]; **and**

performing a network analysis on the relevant patents [Grune, 0003, search and analysis of patents. 0026, analyze each technology (protected or not protected by IP) in terms of specific type, specific quantity, specific terminology, and specific value or any other pertinent and related category contained within various databases.].

Claim 4:

The method of claim 1, further comprising clusterizing patents according to word similarity [Grune, 0033, analyzes the frequency of character strings in documents.].

Claim 5:

The method of claim 1, further comprising generating a visualization of the patents for display on a screen or plotting on a large format plotter [Grune, 0060, visual results are displayed in split or full-screen format.].

Claim 6:

The method of claim 1, further comprising three-dimensionally visualizing the patents on a 3D display device [Grune, 0010, three dimensions].

Claim 7:

The method of claim 1, further comprising allowing a user to review the search result and revise the query [Grune, 0023, allows user to review information and extracted pertinent information. Grune, 0026, allows for a user to determine an arbitrary starting point for analysis, while allowing for a final audio/visual means to quantitatively analyze each technology in terms of specific type, quantity, etc.].

Claim 8:

The method of claim 1, further comprising caching results from prior IP maps in a remote computer [Grune, 0045, The results are modeled for display. This may require information to be ordered, tabulated, or otherwise formatted for each type of visual or audio display specified by user.].

Claim 9:

The method of claim 8, further comprising retrieving a cached IP map in response to a user request [Grune, 0048, The program allows for simultaneous modeling of the valuation and intellectual property results. The results may be displayed in various graphical formats.].

Claim 10:

The method of claim 8, further comprising periodically flushing cached IP maps to ensure a fresh IP map [Grune, 0014, user is able to create new search, thus a new map].

Claim 11:

The method of claim 1, further comprising distributing a search over a plurality of client computers [Grune, 0028, client computers].

Claim 12:

The method of claim 11, wherein one of the client computers is located behind a firewall, further comprising bypassing the firewall in sending distributed search results to a remote computer [Grune, 0015, the client computer will use security procedures to prevent users from inappropriately gaining information from the server computer.].

Claim 13:

The method of claim 1, further comprising annotating a patent at a local computer and caching the annotated patent at a remote computer to satisfy a subsequent request for said patent [Grune, 0015, saving results of the resulting files.].

Claim 16:

A system for mapping intellectual property, comprising:

means for searching one or more remote databases for one or more relevant patents [Grune, 0027, allows a user to enter a query via a client computer that is connected to a server on a global area network. Intelligent searching also provides a user access to the stored intellectual property and scientific information contained on various databases.]; **and**

means for performing a network analysis on the relevant patents [Grune, 0003, search and analysis of patents. Grune, 0026, analyze each technology (protected or not protected by IP) in terms of specific type, specific quantity, specific terminology, and specific value or any other pertinent and related category contained within various databases.].

Claim 17:

The system of claim 16, further comprising means for generating a computer-readable intellectual property mapping file [Grune, 0048, graphical formats.].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 14-15, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2003/0004936 by Grune et. al. (hereafter Grune) as

Art Unit: 2167

applied to claim 1, 4-13, 16-17 above, and further in view of U.S. Patent Application Publication 2004/0123235 by Yeh et. al. (hereafter Yeh).

Claim 2:

The method of claim 1, further comprising

Grune discloses, **receiving as a query one or more keywords or assignees to be searched** [Grune, 0030, searches may include but not limited to keywords, inventor, current assignee, etc.];

searching the query in Issued Patent or Published Application databases [Grune, 0028, access stored intellectual property and scientific information contained in the various databases.];

Grune does not explicitly disclose **retrieving cited prior art patents for each patent found in search results**. On the other hand, Yeh discloses, [0038], a citation analysis module is used to generate citation information of a designated patent according to patent summary information stored in the patent information table. That is, cited patents are retrieved. Both inventions are relate to patent database manipulation. It would have been obvious to have modified Grune to have included the step of **retrieving cited prior art patents for each patent found in search results** based on the disclosure of Yeh. A skilled artisan would have been motivated to do so for the purpose of assisting the user to analyze development trends and directions of technologies.

Art Unit: 2167

Grune modified with Yeh discloses **updating the query by adding assignees from the cited prior art patents and running a second search using the updated query**. Grune discloses that after information related to query is retrieved, data is sent to SIPS-VSM's utilities [0011].

Which further filters the results of the query such as grouping a result according to subject, publication date, assignee etc. In doing so a second search (updated query) is run in order to group documents.

Claim 14:

A method for mapping intellectual property, comprising:

Grune discloses **(a) receiving as a query one or more keywords or assignees to be searched** [0030, searches may include but not limited to keywords, inventor, current assignee, etc.];

(b) searching the query in Issued Patent or Published Application databases [0028, access stored intellectual property and scientific information contained in the various databases.];

Grune does not explicitly disclose **(c) retrieving cited prior art for each patent found as search results**. On the other hand, Yeh discloses, [0038], a citation analysis module is used to generate citation information of a designated patent according to patent summary information stored in the patent information table. That is, cited patents are retrieved. Both inventions are related to patent database manipulation. It would have been obvious to have modified Grune to have included the step of **retrieving cited prior art patents for each patent found in search**

results based on the disclosure of Yeh. A skilled artisan would have been motivated to do so for the purpose of assisting the user to analyze development trends and directions of technologies.

Grune modified with Yeh discloses **(d) updating the query by adding assignees from the cited prior art and (e) iteratively repeating (b)-(d) using the updated query**. Grune discloses that after information related to query is retrieved, data is sent to SIPS-VSM's utilities [0011]. Which further filters the results of the query such as grouping a result according to subject, publication date, assignee etc. Grune further discloses, 0015, refined query, running a search again.

Claim 15:

The method of claim 14, further comprising network analyzing the search results [Grune, 0003, search and analysis of patents. 0026, analyze each technology (protected or not protected by IP) in terms of specific type, specific quantity, specific terminology, and specific value or any other pertinent and related category contained within various databases.].

Claim 18:

The system of claim 17, wherein the IP mapping file comprises:

Grune does not explicitly disclose **a collection of patent documents, each having one or more links embedded in the first portion referencing one or more external documents viewable using a viewer application; and one or more links embedded in the third portion referencing information contained in the second portion; and links generated by a network**

Art Unit: 2167

analysis of relationships among the patent documents. On the other hand, Yeh discloses a 0045, a patent citation tree generated in accordance with data stored in the patent information table. The citation analyzing module generates citation links among a plurality of patents according to the summary data stored in the patent information table. The node generating module of the client computer generates node data structure. Each node in the node data structure represents a patent. The link generating module generates sub-node links between the nodes, and adds sub-node links to the node data structure. Each sub-node link represents one or more citation links, and connects one node with its respective one or more nodes. Yeh further discloses, 0048, that the node link structures are displayed in hyperbolic plane in the display unit. Both inventions are related to patent database manipulation. It would have been obvious to have modified Grune to have included the step of **a collection of patent documents, each having one or more links embedded in the first portion referencing one or more external documents viewable using a viewer application; and one or more links embedded in the third portion referencing information contained in the second portion; and links generated by a network analysis of relationships among the patent documents** based on the disclosure of Yeh. A skilled artisan would have been motivated to do so for the purpose of assisting the user to analyze development trends and directions of technologies.

Claim 19:

A computer readable media containing executable computer program instructions which when executed on a digital processing system causes the system to perform a method comprising:

Grune discloses **receiving as a query one or more keywords or assignees to be searched** [Grune, 0030, searches may include but not limited to keywords, inventor, current assignee, etc.];

searching the query in Issued Patent or Published Application databases [Grune, 0028, access stored intellectual property and scientific information contained in the various databases.];

Grune does not explicitly disclose **retrieving cited prior art patents for each patent found in search results**. On the other hand, Yeh discloses, [0038], a citation analysis module is used to generate citation information of a designated patent according to patent summary information stored in the patent information table. That is, cited patents are retrieved. Both inventions are relate to patent database manipulation. It would have been obvious to have modified Grune to have included the step of **retrieving cited prior art patents for each patent found in search results** based on the disclosure of Yeh. A skilled artisan would have been motivated to do so for the purpose of assisting the user to analyze development trends and directions of technologies.

Grune modified with Yeh discloses **updating the query by adding assignees from the cited prior art patents, running a second search using the updated query, and performing a network analysis on the search results**. Grune discloses that after information related to query is retrieved, data is sent tot SIPS-VSM's utilities [0011]. Which further filters the results of the query such as grouping a result according to subject, publication date, assignee etc. Grune

Art Unit: 2167

further discloses, 0015, refined query, running a search again, and 0003, search and analysis of patents. 0026, analyze each technology (protected or not protected by IP) in terms of specific type, specific quantity, specific terminology, and specific value or any other pertinent and related category contained within various databases.

Claim 20:

The media of claim 19, further comprising instructions to distribute the processing over a plurality of computers [Grune, Figure 5 illustrates plurality of computers. Namely a client and server.].

Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2003/0004936 by Grune et. al. (hereafter Grune) as applied to claim 1, 4-13, 16-17 above, and further in view of "On-line Animated Visualization of Huge Graphs using a Modified Spring Algorithm" by Haung et. al. (hereafter Haung).

Claim 3:

The method of claim 1, further comprising:

Grune does not explicitly disclose for each patent, creating spring relationship among patents based on number of citation of patent prior art; and generating a spring mass diagram. On the other hand, Huang discloses figures 9 and 10 graphed diagrams utilizing a spring algorithm for visualization. All systems are directed to visualization in database technology. It would have been obvious to one of ordinary skill at the time the invention was

Art Unit: 2167

made to have modified Grune to have included the step of **for each patent, creating spring relationship among patents based on number of citation of patent prior art; and generating a spring mass diagram** based on the disclosure of Huang. A skilled artisan would have been motivated to do so for the purpose of visualizing huge graphs.

Conclusion

The prior art made of record listed on PTO-892 and not relied, if any, upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael D. Pham whose telephone number is (571)272-3924. The examiner can normally be reached on Monday - Friday 9am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2167


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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